UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trad mark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MK

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/652,485	08/31/00	SINGH R	00-2-025

IM22/0829

ROBERT F CLARK
OSRAM SYLVANIA INC
100 ENDICOTT STREET
DANVERS MA 01923

EXAMINER	
WYSZOMIERSKI,G	
ART UNIT	PAPER NUMBER
1742	3

DATE MAILED: 08/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary	Application No.	Applicant(s)	
	09/652,485	SINGH ET AL.	
	Examiner	Art Unit	
	George P Wyszomierski	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) *3-5* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 August 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1 and 2, drawn to a powder, classified in class 423, subclass 592.

II. Claims 3-5, drawn to a process, classified in class 75, subclass 369.

2. The inventions are distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process, such as a process of making electrodes for batteries.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Robert Clark, attorney of record, on August 24, 2001 a provisional election was made with oral traverse to prosecute the invention of Group I, claims 1 and 2. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3-5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamada et al. (U.S. Patent 6,054,110).

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gingerich et al. (U.S. Patent 4,218,240) or JP 10-188970.

Each of Yamada, Gingerich, and JP '970 discloses heterogenite powder material, also known as CoOOH or $HCoO_2$. The prior art does not specify the surface area of their respective materials. However, note that page 3 of the present specification indicates that heterogenite

powder having the designated particle size is said to be produced by heating or drying cobalt hydroxide at 110°C. All of the above prior art forms their respective heterogenite material by heating to the same or similar temperature; see Gingerich column 5, lines 42-60, Yamada column 3, line 59, or the Abstract of '970. Because the prior art materials appear to be of the same chemical composition and produced in substantially the same manner as the inventive material, the examiner's position is that the prior art materials are substantially identical to those as presently claimed (within the meaning of 35 USC 102), absent evidence to the contrary.

At the very least, the examiner's position is that one of ordinary skill in the art would be aware of the relationship between surface area and such parameters as particle size, density, and packing factors. Further, one of ordinary skill in the art would have been able to control the particle size of the heterogenite material obtained in the prior art through control of one or more of these parameters. Therefore, the making of heterogenite materials of a given surface area, such as the surface area recited in the instant claims, would have been well within the level of one of ordinary skill in the art, given the disclosures of Gingerich, Yamada, or JP '970.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wei et al. (U.S. Patent 5,984,982), or JP 11-60242 or 11-176433.

The Wei, '242, and '433 documents disclose heterogenite powders, but do not recite the surface area of such powders as presently claimed. The examiner's position is that heterogenite materials having a surface area within the range of the instant claims would fall withn the purview of the materials as described in the prior art. Further, one of ordinary skill in the art would be aware of the relationship between surface area and such parameters as particle size, density, and packing factors, and would have been able to control the particle size of the heterogenite material obtained in the prior art through control of one or more of these

parameters. Therefore, the making of heterogenite materials of a given surface area, such as the surface area recited in the instant claims, would have been well within the level of one of ordinary skill in the art, given the disclosures of Wei et al. or JP '242 or '433.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (703) 308-2531. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (703) 308-1146. The fax phone number for this Group is (703) 305-7719. The Right fax number for this examiner is (703) 872-9039. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

GEORGE WYSZOMIERSKI
PRIMARY EXAMINER

GPW
August 28, 2001